

### **Remarks**

This pending application is a reissue continuation of 09/776,394, which is a reissue application of U.S. Patent No. 5,865,846.

Claims 4-9, 13, 30, 31, 33-35, and 37 are pending in the application. This paper amends independent claim 33 to further define the claimed subject matter. Accordingly, claim 33 and its associated dependent claims should be in condition for allowance.

Reconsideration of the presently pending claims is respectfully requested in light of the following remarks.

### **Premature Finality**

The Office Action has been prematurely made final and Applicants request that the finality of the Office Action be withdrawn. As set forth in MPEP §706.07(a):

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)....”

To justify the finality of the presently outstanding Office Action, the Office indicates that the Applicants amendment necessitated the new ground of rejection. However, the only amendment to the claims made in the last filed response added the subject matter of an allowable dependent claim to a rejected independent claim. No other changes to the claims were made. Therefore, the amendment did not require an additional search or consideration because the scope of the amended independent claim was the same as the scope of the examined dependent claim. Therefore, the finality of the Office Action is premature and Applicants respectfully request that the finality be withdrawn.

### Reissue Oath/Declaration

The Office Action indicates that the claims stand rejected as being based upon a defective oath or declaration. Pg. 2. It also indicates that receipt of an appropriate supplemental oath will overcome the rejection. Applicants will file the supplemental oath after the Office indicates that all the claims are allowable over the prior art.

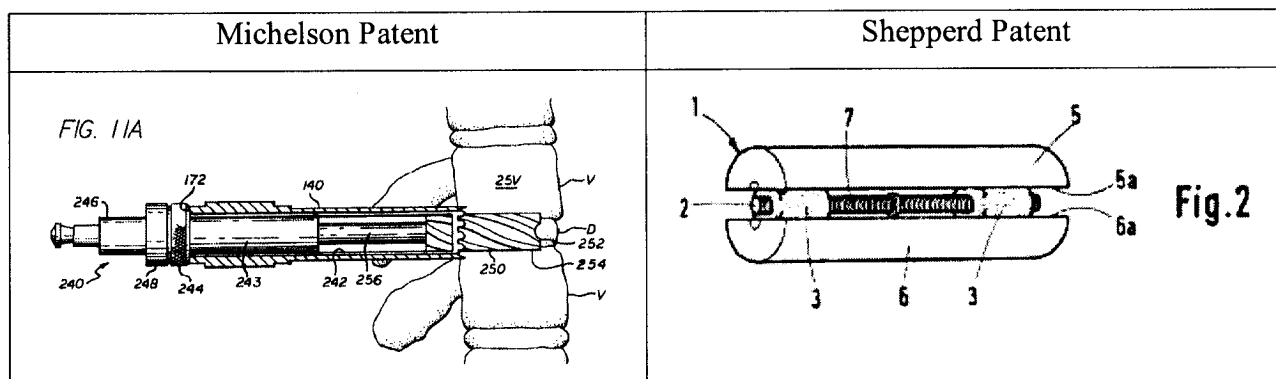
### Compliance with 35 U.S.C. § 102 and § 103

The Office Action rejects claims 33, 35, and 37 in view of U.S. Patent No. 4,863,476 to Shepperd in view of U.S. Patent No. 5,484,437 to Michelson. Applicants understand this rejection to be based on a combination of the references under §103 instead of §102 as written because it states that at least Shepperd does not teach all the features of the claims. This paper amends independent claim 33 to include clarifying subject matter that was already inherent in the claims. For the convenience of the Examiner, claim 33 is reproduced below to show the changes introduced in this paper.

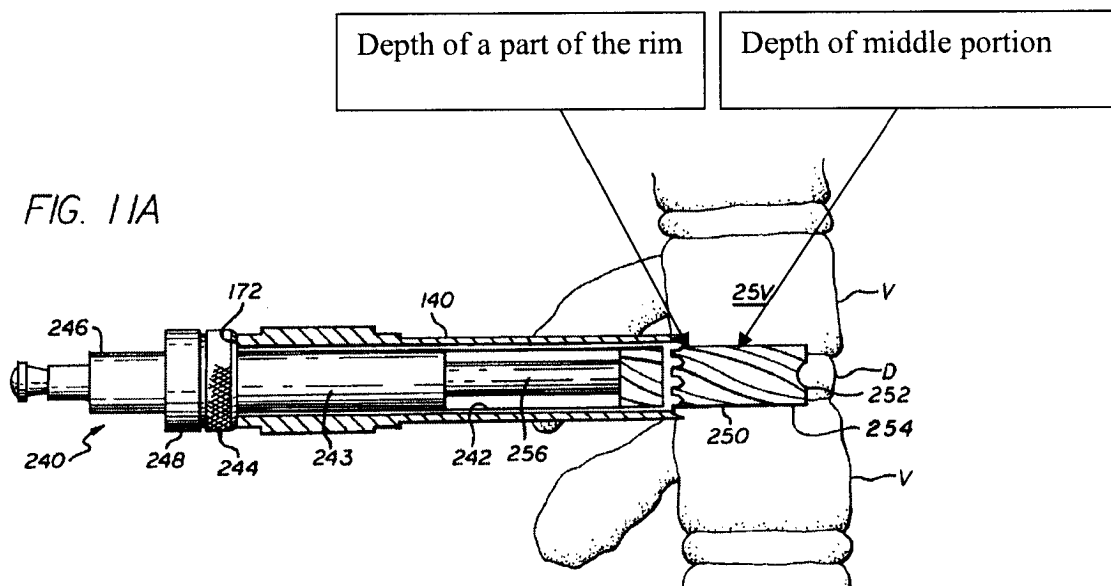
33. A method for inserting an intervertebral disc prosthesis having a first and second surface, the method comprising:  
after removal of an intervertebral disc, forming a first indentation in a first endplate of a first vertebral body, the first indentation having a middle portion and a circumferential rim extending entirely about the middle portion, such that the middle portion is deeper into the first vertebral body than any part of the circumferential rim;  
fixedly mating the first surface to the first indentation of the first endplate of the first vertebral body, the first surface having a shape that conforms to the first indentation; and  
fixedly mating the second surface to a second vertebral body, wherein the first and second surfaces are capable of relative movement after being mated to the first and second vertebral bodies, respectively.

The newly added subject matter was inherent in the claim because a circumference already necessarily extended about the entire middle portion. Nevertheless, to advance prosecution, claim is amended to more particularly define the circumferential rim.

As can be seen in the reproduced drawings below, both Shepperd and Michelson teach cylindrical implants or forming a cylindrical bore.



However, a cylindrical bore does not have an “indentation having a middle portion and a circumferential rim extending entirely about the middle portion, such that the middle portion is deeper into the first vertebral body than any part of the circumferential rim.” Instead, a cylindrical bore as shown in Michelson has at least one part along the circumferential rim that has *the same deepness as the middle portion* as shown in the drawing above.



As shown above, a part of the circumferential rim has the same depth as the middle portion. The cylindrical implant in Shepperd doesn't change the result. There is no teaching or suggestion in either of these references of the claimed subject matter of:

forming a first indentation in a first endplate of a first vertebral body, the first indentation having a middle portion and a circumferential rim extending entirely about the middle portion, such that the middle portion is deeper into the first vertebral body than any part of the circumferential rim

Applicants respectfully request that the Examiner withdraw the rejection of claim 33 and its associated dependent claims.

Conclusion

In view of the foregoing remarks, all of the claims currently pending in this application are in a condition for allowance over the prior art. Once the Office formerly indicates that all the claims are allowable over the prior art, Applicants will submit a supplemental oath or declaration.

A telephone interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application. The Office Action contains characterizations of the claims and the related art of which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Respectfully submitted,



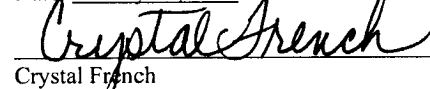
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Dated: January 19, 2010

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Attorney Docket No.: 31132.189/PC904.08  
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I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date: January 19, 2010

  
Crystal French